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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,294	07/17/2003	Reid Lee	5150-40801	2482

7590   06/05/2007
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ART UNIT	PAPER NUMBER
3625	

MAIL DATE	DELIVERY MODE
06/05/2007	PAPER

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PTOL-90A (Rev. 04/07)

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

JUN 0 5 2007

GROUP 3600

Application Number: 10/621,294
Filing Date: July 17, 2003
Appellant(s): LEE, REID

Jeffrey C. Hood
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 22, 2007 appealing from the Final

Office action mailed July 27, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: On page 10 of the Appeal Brief, the appellant states that claims 1-76 were rejected under 35 U.S.C. §102(e). This is

incorrect and appears to be a typographical error. Claims 1-76 were rejected under 35

U.S.C. 103(a) as being unpatentable over Henson (US 6,167,383) in view of IBM

Technical Disclosure Bulletin ("IBM") and further in view of Motomiya et al (US

6,083,267) ("Motomiya").

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,167,383	Henson	12-2000
6,083,267	Motomiya et al.	7-2000

IBM Technical Disclosure Bulletin "*Visual Configurator System For Configuring and

Ordering IBM Products*", Vol. 34, No. 12, May 1992.

Additional evidence cited

"PenRight unleashes Windows tool" by Diana Hwang ("Hwang");

"Sequent exec leaves to 'take a shot at Internet gold rush'" by Anita Marks ("Marks")

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US 6,167,383) in view of IBM Technical Disclosure Bulletin hereafter referred to as "IBM" and further in view of Motomiya et al (US 6,083,267) hereafter referred to as "Motomiya".

Referring to claim 1: Henson teaches a method for enabling a user to configure a system in an e-commerce system, wherein the e-commerce system includes a client system coupled through a network to an electronic commerce server (*Figure 2, "44", "38", and "10"; col. 5, line 66 – col. 6, line 4*), the method comprising:

- receiving a request from a user via the network of the client system to configure the system, wherein the system includes one or more customizable components (*column 4, lines 36-52; Figure 3A, "Hard Drive", "Video Card"; Figure 3B, "Network Card"*);

- determining customizable component selections for at least one of the one or more customizable components of the system in response to user input (*col. 6, lines 18-30; col. 7, lines 39-56; Figure 3A, "75" and "76"; Figure 3B, "86"*), wherein said determining customizable component selections comprises:

receiving user input via the network selecting a first customizable

component option for the first customizable component, wherein the user

input selecting the first customizable component option comprises the

customizable component selection for the first customizable component

(*col. 6, lines 18-30; col. 7, lines 39-56; Figure 3A, "75" and "76"; Figure 3B, "86"*);

wherein the customizable component selections applied to the system

specify a configured system (*col. 7, line 57 – col. 8, line 6*).

Henson does not teach providing an image of the system to the client system for

display, wherein images of at least a subset of the one or more customizable

components form at least a portion of the image of the system.   However, IBM

discloses a method of configuring a system that provides an image of the system to the

client system for display, wherein images of at least a subset of the one or more

customizable components form at least a portion of the image of the system (*Page 368:*

"The 'Visual Configurator' (VC) concept presents one with a picture of an empty machine, and through the

use of a mouse, the user is presented with menus of potential device that can be installed in various

locations of the machine under configuration."; Page 369, Figure 2).   Therefore it would have been

obvious to one of ordinary skill in the art, at the time the invention was made, to

incorporate the teachings of IBM into the method of Henson. One of ordinary skill in the

art would have been motivated to do so in order to provide a *"...user with visual feedback as*

to how many I/O slots are available in the machine, how many hardfiles the machine can

accommodate..." as taught by IBM (*Page 369*). Henson does not teach receiving user input

selecting an image of a first customizable component which is visually depicted in the

image of the system, wherein said receiving user input selecting the image of the first

customizable component operates to select the first customizable component for
configuration. However, IBM teaches a method of configuring a system that receives
user input selecting an image of a first customizable component which is visually
depicted in the image of the system, wherein said receiving user input selecting the
image of the first customizable component operates to select the first customizable
component for configuration (*page 370, lines 17-19: "...the VC allows one to point and click the
mouse for a desired device in any order the user wishes." and lines 42-46: "By clicking the mouse over a
particular location in the window that graphically displays the layout of the inside of the machine, a list of
options that will fit into that particular location is displayed. For example, if one clicks the mouse over an
DASD bay, a list of DASD devices that are allowed in that slot are presented in a menu."*) Therefore it
would have been obvious to one of ordinary skill in the art, at the time the invention was
made, to incorporate the teachings of IBM into the method of Hanson. One of ordinary
skill in the art would have been motivated to do so in order to provide a *"...user with visual
feedback as to how many I/O slots are available in the machine, how many hardfiles the machine can
accommodate..."* as taught by IBM (*Page 369*). The cited prior art does not teach that the
image is provided to the client system via a network, or that the user selects an image
via a network. However, Motomiya teaches an Internet-based configuration method
and program that allows a user to configure a variety of products (*Abstract*) and where
the image is provided to the client system via a network and where the user selects an
image via a network (Figures 5A – Figure 6B). Therefore it would have been obvious to
one of ordinary skill in the art, at the time the invention was made, to incorporate the
teachings of Motomiya into the cited prior art. One of ordinary skill in the art would have

been motivated to do so in order to provide the customer with a display of the product as it was being configured.

Referring to claim 2: The cited prior art teaches or suggests all the limitations of claim 1 as noted above. Furthermore, Henson provides a text display of the final configured system (*Figure 6, item "104"*) and shows an image of a "Dell Dimension XPS R" computer system (*Figures 3A and Figure 4, item "70"*). Moreover, Motomiya teaches an Internet-based configuration method and program that allows a user to configure a variety of products (*Abstract*). Motomiya teaches displaying an image of the final customized product to the client system wherein the image of the customized product visually depicts the customizable component selections of the user at their respective locations on the image of the customized product (*column 5, lines 41-67; column 6, lines 1-35; Figure 6A, item 63; Figure 6B*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide the customer with a display of the final configured product before the customer placed an order for the product.

Referring to claim 3: The cited prior art teaches or suggests all the limitations of claim 2 as noted above. Furthermore, Motomiya teaches that providing the image of the configured system includes providing customizable component selection images corresponding to the customizable component selections of the user (*Figure 6A, item "62"; Figure 6B*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the

invention of Henson and IBM. One of ordinary skill in the art would have been

motivated to do so in order to provide the customer with a display of the final configured

product with the customized components before the customer placed an order for the

product.

Referring to claim 4: The cited prior art teaches or suggests all the limitations of

claim 3 as noted above. Furthermore, Motomiya teaches visually depicting a subset of

the customizable component selection images at their respective locations on the image

of the configured product (*Figures 5A-6B*). Therefore it would have been obvious to one

of ordinary skill in the art, at the time the invention was made, to incorporate the

teachings of Motomiya into the invention of Henson and IBM. One of ordinary skill in

the art would have been motivated to do so in order to provide the customer with a

display of the final configured product with the customized components at their

respective locations before the customer placed an order for the product.

Referring to claim 5: The cited prior art teaches or suggests all the limitations of

claim 2 as noted above. Furthermore, Motomiya teaches providing text corresponding

to the customizable component selections of the user; wherein the text is displayed in

the image of the configured system (*Figure 6B: "Equipment" and "Fasteners"*). Therefore it

would have been obvious to one of ordinary skill in the art, at the time the invention was

made, to incorporate the teachings of Motomiya into the invention of Henson and IBM.

One of ordinary skill in the art would have been motivated to do so in order to provide

the customer with a display of the final configured product with the customized

components at their respective locations before the customer placed an order for the product.

Referring to claim 6: The cited prior art teaches or suggests all the limitations of claim 2 as noted above. Furthermore, Motomiya teaches that the image of the configured product is viewable by the user and used by the user to evaluate and confirm the customizable component selections (*Figures 5A-6B*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the method and program of cited prior art. One of ordinary skill in the art would have been motivated to do so in order to allow a user to see the configured product before placing an order.

Referring to claim 7: The cited prior art teaches or suggests all the limitations of claim 2 as noted above. Furthermore, Henson teaches receiving one or more new customizable component selections for at least one of the one or more customizable components of the configured system after said providing the image of the configured system to the client system, wherein the new customizable component selections applied to the configured system specify a new configured system (*Figure 6, "104" "Edit"*). The cited prior art does not teach providing an image of the new configured system, wherein the image of the new configured system visually depicts the new customizable component selections of the user. However, Motomiya teaches providing an image of the configured system, wherein the image of the configured system visually depicts the customizable component selections of the user (*Figure 6A, item "62"; Figure 6B*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention

was made, to incorporate the teachings of Motomiya into the invention of Henson and

IBM. One of ordinary skill in the art would have been motivated to do so in order to

provide the customer with a display of the final configured product with the customized

components before the customer placed an order for the product.

Referring to claim 8: The cited prior art teaches or suggests all the limitations of

claim 7 as noted above. Furthermore, IBM teaches receiving user input selecting a first

customizable component (*page 370, lines 17-19*: *"...the VC allows one to point and click the mouse*

for a desired device in any order the user wishes."); providing a menu of possible options for the

first customizable component to the client system for display after the user input

selecting the first customizable component; receiving user input selecting one of the

possible options for the first customizable component (*page 370, lines 42-46*: *"By clicking the*

mouse over a particular location in the window that graphically displays the layout of the inside of the

machine, a list of options that will fit into that particular location is displayed. For example, if one clicks

the mouse over an DASD bay, a list of DASD devices that are allowed in that slot are presented in a

menu."; Page 368: *"The 'Visual Configurator' (VC) concept presents one with a picture of an empty*

machine, and through the use of a mouse, the user is presented with menus of potential device that can

be installed in various locations of the machine under configuration."; Page 369, Figure 2). Therefore it

would have been obvious to one of ordinary skill in the art, at the time the invention was

made, to incorporate the teachings of IBM into the method of the cited prior art. One of

ordinary skill in the art would have been motivated to do so in order to provide a *"...user*

with visual feedback as to how many I/O slots are available in the machine, how many hardfiles the

machine can accommodate..." as taught by IBM (*Page 369*).

Referring to claims 9 and 10: The cited prior art teaches or suggests all the

limitations of claim 1 as noted above. Furthermore, IBM teaches receiving user input

indicating that a position of a cursor of the client system overlaps a location of the image

of the first customizable component displayed in the image of the system (*page 370, lines

42-46*: *"By clicking the mouse over a particular location in the window that graphically displays the layout*

of the inside of the machine, a list of options that will fit into that particular location is displayed. For

example, if one clicks the mouse over an DASD bay, a list of DASD devices that are allowed in that slot

are presented in a menu."; *Page 368*: *"The 'Visual Configurator' (VC) concept presents one with a picture*

of an empty machine, and through the use of a mouse, the user is presented with menus of potential

device that can be installed in various locations of the machine under configuration."; *Page 369, Figure*

2). Therefore it would have been obvious to one of ordinary skill in the art, at the time

the invention was made, to incorporate the teachings of IBM into the method of the cited

prior art. One of ordinary skill in the art would have been motivated to do so in order to

provide a *"...user with visual feedback as to how many I/O slots are available in the machine, how*

many hardfiles the machine can accommodate..." as taught by IBM (*Page 369*).

Referring to claim 11: The cited prior art teaches or suggests all the limitations of

claim 10 as noted above. Furthermore, IBM teaches that the menu comprising the

customizable component options includes text (i.e. list) indicating the customizable

component options (*page 370, lines 42-46; Figure 2*). Therefore it would have been obvious

to one of ordinary skill in the art, at the time the invention was made, to incorporate the

teachings of IBM into the method of the cited prior art. One of ordinary skill in the art

would have been motivated to do so in order to provide a *"...user with visual feedback as to*

how many I/O slots are available in the machine, how many hardfiles the machine can accommodate..."

as taught by IBM (*Page 369*).

Referring to claims 12 and 14: The cited prior art teaches or suggests all the limitations of claim 10 as noted above. The cited prior art does not teach that the menu comprising the customizable component options includes images indicating the customizable component options. However, the Examiner notes that this limitation is not functionally involved in the steps of the recited method. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps of receiving and providing would be performed the same regardless of what was displayed in the menu of the cited prior art. The differences between the Applicant's invention and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)* also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display an image of the component in the menu of the cited prior art because such content does not functionally relate to the steps of the claimed method and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claim 13: The cited prior art teaches or suggests all the limitations of claim 10 as noted above. Furthermore, IBM teaches the menu is operable to be displayed proximate to the location of the image of the first customizable component (*Figure 2*). Therefore it would have been obvious to one of ordinary skill in the art, at the

time the invention was made, to incorporate the teachings of IBM into the method of the

cited prior art. One of ordinary skill in the art would have been motivated to do so in

order to provide a *"...user with visual feedback as to how many I/O slots are available in the machine,

how many hardfiles the machine can accommodate..."* as taught by IBM (*Page 369*).

Referring to claim 15: The cited prior art teaches or suggests all the limitations of

claim 10 as noted above. Furthermore, IBM teaches providing customizable component

options corresponding to the customizable component options of the first customizable

component; and receiving user input selecting a first customizable component option

image corresponding to the first customizable component option. IBM teaches in Figure

2 that the user selects the image of "slot 1" and is presented with a menu having a set

of component options for configuring "slot 1". Therefore it would have been obvious to

one of ordinary skill in the art, at the time the invention was made, to incorporate the

teachings of IBM into the method of the cited prior art. One of ordinary skill in the art

would have been motivated to do so in order to provide a with visual feedback of the

customizable component options for a first customizable component as taught by IBM

(*Page 369*). IBM does not teach that the component options are images. However, the

Examiner notes that this limitation is not functionally involved in the steps of the recited

method. Therefore this limitation is deemed to be nonfunctional descriptive material.

The steps of receiving and providing would be performed the same regardless of what

was displayed in the menu of the cited prior art. The differences between the

Applicant's invention and the prior art are merely subjective. Thus this nonfunctional

descriptive material will not distinguish the claimed invention from the prior art in terms

of patentability, see *In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir.
1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)* also see MPEP
2106. Therefore, it would have been obvious to a person of ordinary skill in the art at
the time the invention was made to display an image of the component in the menu of
the cited prior art because such content does not functionally relate to the steps of the
claimed method and because the subjective interpretation of information does not
patentably distinguish the claimed invention.

Referring to claim 17: Henson teaches a method for enabling a user to configure
a system in an e-commerce system, wherein the e-commerce system includes a client
system coupled through a network to an electronic commerce server (*Figure 2, "44", "38",
and "10"; col. 5, line 66 – col. 6, line 4*), the method comprising:

- receiving a request from a user of the client system to configure the system,
  wherein the system includes one or more customizable components (*column 4,
  lines 36-52; Figure 3A, "Hard Drive", "Video Card"; Figure 3B, "Network Card"*);

- receiving customizable component selections for at least one of the one or more
  customizable components of the system in response to user input (*col. 6, lines 18-
  30; col. 7, lines 39-56; Figure 3A, "75" and "76"; Figure 3B, "86"*), wherein said receiving
  customizable component selections comprises:

      receiving user input selecting a first customizable component option for
      the first customizable component, wherein the user input selecting the first
      customizable component option comprises the customizable component

selection for the first customizable component (*col. 6, lines 18-30; col. 7, lines 39-56; Figure 3A, "75" and "76"; Figure 3B, "86"*);

wherein the customizable component selections applied to the system specify a configured system (*col. 7, line 57 – col. 8, line 6*).

Henson does not teach providing an image of the system to the client system for display, wherein images of at least a subset of the one or more customizable components form at least a portion of the image of the system. However, IBM discloses a method of configuring a system that provides an image of the system to the client system for display, wherein images of at least a subset of the one or more customizable components form at least a portion of the image of the system (*Page 368: "The 'Visual Configurator' (VC) concept presents one with a picture of an empty machine, and through the use of a mouse, the user is presented with menus of potential device that can be installed in various locations of the machine under configuration."; Page 369, Figure 2*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of IBM into the method of Henson. One of ordinary skill in the art would have been motivated to do so in order to provide a *"...user with visual feedback as to how many I/O slots are available in the machine, how many hardfiles the machine can accommodate..."* as taught by IBM (*Page 369*). Henson does not teach receiving user input selecting an image of a first customizable component which is visually depicted in the image of the system, wherein said receiving user input selecting the image of the first customizable component operates to select the first customizable component for configuration. However, IBM teaches a method of configuring a system that receives user input selecting an image of a first customizable component which is visually

depicted in the image of the system, wherein said receiving user input selecting the

image of the first customizable component operates to select the first customizable

component for configuration (*page 370, lines 17-19*: "*...the VC allows one to point and click the*

mouse for a desired device in any order the user wishes." *and lines 42-46*: "*By clicking the mouse over a*

particular location in the window that graphically displays the layout of the inside of the machine, a list of

options that will fit into that particular location is displayed. For example, if one clicks the mouse over an

DASD bay, a list of DASD devices that are allowed in that slot are presented in a menu.") Therefore it

would have been obvious to one of ordinary skill in the art, at the time the invention was

made, to incorporate the teachings of IBM into the method of Hanson. One of ordinary

skill in the art would have been motivated to do so in order to provide a "*...user with visual*

feedback as to how many I/O slots are available in the machine, how many hardfiles the machine can

accommodate..." as taught by IBM (*Page 369*). The cited prior art does not teach that the

system displayed and configured is a "measurement" system. However, the Examiner

notes that this limitation is not functionally involved in the steps of the recited method.

Therefore this limitation is deemed to be nonfunctional descriptive material. The steps

of receiving and providing would be performed the same regardless of what system was

displayed on the computer screen. The differences between the content of what is

displayed on the computer screen of the Applicant's invention and the prior art are

merely subjective. Thus this nonfunctional descriptive material will not distinguish the

claimed invention from the prior art in terms of patentability, see *In re Gulack, 703 F.2d*

1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32

USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been

obvious to a person of ordinary skill in the art at the time the invention was made to

display any system in the invention of the cited prior art because what is displayed on

the computer screen does not functionally relate to the steps of the claimed method and

because the subjective interpretation of information does not patentably distinguish the

claimed invention. The cited prior art does not teach that the image is provided to the

client system via a network, or that the user selects an image via a network. However,

Motomiya teaches an Internet-based configuration method and program that allows a

user to configure a variety of products (*Abstract*) and where the image is provided to the

client system via a network and where the user selects an image via a network (Figures

5A – Figure 6B). Therefore it would have been obvious to one of ordinary skill in the art,

at the time the invention was made, to incorporate the teachings of Motomiya into the

cited prior art. One of ordinary skill in the art would have been motivated to do so in

order to provide the customer with a display of the product as it was being configured.

Referring to claims 18, 34, 56, 66, 73: Claims 18, 34, 56, 66, and 73 are rejected

under the same rationale as set forth above in claim 2.

Referring to claims 19 and 35: Claims 19 and 35 are rejected under the same

rationale as set forth above in claim 3.

Referring to claims 20 and 36: Claims 20 and 36 are rejected under the same

rationale as set forth above in claim 4.

Referring to claims 21 and 37: Claims 21 and 37 are rejected under the same

rationale as set forth above in claim 5.

Referring to claims 22 and 38: Claims 22 and 38 are rejected under the same

rationale as set forth above in claim 6.

Referring to claims 23 and 39: Claims 23 and 39 are rejected under the same rationale as set forth above in claim 7.

Referring to claims 24 and 40: Claims 24 and 40 are rejected under the same rationale as set forth above in claim 8.

Referring to claims 25, 26, 41, 42, and 53: Claims 25, 26, 41, 42, and 53 are rejected under the same rationale as set forth above in claims 9 and 10.

Referring to claims 27 and 43: Claims 27 and 43 are rejected under the same rationale as set forth above in claim 11.

Referring to claims 28 and 44: Claims 28 and 44 are rejected under the same rationale as set forth above in claim 12.

Referring to claims 29, 30, 45, 46, and 54: Claims 29, 30, 45, 46, 54 are rejected under the same rationale as set forth above in claims 13 and 14.

Referring to claims 16, 31, 32, 47, 48, 55, 64, 65, 71, and 72: Claims 16, 31, 32, 47, 48, 55, 64, 65, 71, and 72 are rejected under the same rationale as set forth above in claim 15.

Referring to claims 33, 49, 50, 52, 69, and 76: Claims 33, 49, 50, 52, 69, and 76 are rejected under the same rationale as set forth above in claim 1.

Referring to claims 51 and 62: Claims 51 and 62 are rejected under the same rationale as set forth above in claim 17.

Referring to claim 57: The cited prior art teaches or suggests all the limitations of claim 52 as noted above. Furthermore, Henson teaches receiving payment information for the configured system to purchase the configured system (*Figure 10, "124"*).

Referring to claim 58: The cited prior art teaches or suggests all the limitations of claim 57 as noted above. Furthermore, Henson teaches providing the configured system to a user of the client computer after said receiving payment information for the configured system to purchase the configured system (*col. 11, lines 25-30; col. 12, lines 40-41*).

Referring to claim 59: The cited prior art teaches or suggests all the limitations of claim 52 as noted above. The cited prior art does not teach that the system displayed and configured is a "measurement" system. However, the Examiner notes that this limitation is not functionally involved in the steps of the recited method. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps of receiving and providing would be performed the same regardless of what system was displayed on the computer screen. The differences between the content of what is displayed on the computer screen of the Applicant's invention and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)* also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any system in the invention of the cited prior art because what is displayed on the computer screen does not functionally relate to the steps of the claimed method and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claims 60 and 61: Claims 60 and 61 are rejected under the same rationale as set forth above in claim 1.

Referring to claim 63: The cited prior art teaches or suggests all the limitations of claim 62 as noted above. Furthermore, IBM teaches providing a menu comprising options for the device for display on the client computer after receiving user input selecting the image of the device (*page 370, lines 42-46: "By clicking the mouse over a particular location in the window that graphically displays the layout of the inside of the machine, a list of options that will fit into that particular location is displayed. For example, if one clicks the mouse over an DASD bay, a list of DASD devices that are allowed in that slot are presented in a menu."; Page 368: "The 'Visual Configurator' (VC) concept presents one with a picture of an empty machine, and through the use of a mouse, the user is presented with menus of potential device that can be installed in various locations of the machine under configuration."; Page 369, Figure 2*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of IBM into the method of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide a *"...user with visual feedback as to how many I/O slots are available in the machine, how many hardfiles the machine can accommodate..."* as taught by IBM (*Page 369*).

Referring to claims 67 and 74: Claims 67 and 74 are rejected under the same rationale as set forth above in claim 57.

Referring to claims 68 and 75: Claims 68 and 75 are rejected under the same rationale as set forth above in claim 58.

Referring to claim 70: Claim 70 is rejected under the same rationale as set forth above in claim 63.

(10) Response to Argument

Referring to claim 1, the Appellant's claimed subject matter is directed to a

method for configuring, over a network, a system (e.g. a computer system) having

images of customizable components (e.g. memory, hard drive, video card, etc.). The

method provides an image of the system and images of customizable components to a

user. The user selects an image of a first customizable component (e.g. hard drive) and

is presented with options for this particular customizable component (e.g. 30 GB hard

drive or 40 GB hard drive, etc.). The user selects a particular option for the

customizable component and then the customizable component is applied to the

system.

In rejecting the claim, the examiner applied three references: Henson, IBM, and

Motomiya. The examiner argued that Henson teaches most of the claim language. For

example Henson teaches configuring a computer system over a network (Figures 2, 3A,

and 4), wherein options of customizable component are presented to the user for

selection (Figure 3A, "77", "75"; Figure 5, "92"). These selections are then applied to

the configured system. The examiner stated that Henson does not teach providing an

image of the system or providing images of the customizable component (i.e. Henson is

a text-based configuration system). For these limitations, the examiner introduced the

IBM reference.

IBM teaches a "Visual Configuator System" (VC) for configuring and ordering

IBM products (i.e. IBM computers). IBM teaches presenting a user with an image of the

configured system and customizable components (e.g. Figure 2 shows an image of a

computer system along with an image and options for the video adapter). IBM teaches

that the VC is an improvement over a known text-based configuration system. IBM

states "*It would be easier to those not familiar with the IBM product to display a 'picture' of the machine*

to be ordered and allow the user to 'fill up the empty slots'" (page 369, lines 4-6). The examiner

then gave a motivation for combining the teachings of IBM with Henson (i.e. to provide

visual feedback to the user).

The Appellant has argued that the Visual Configurator (VC) taught by IBM

teaches away from the features of claim 1 because the VC runs on a stand-alone DOS-

based PC system and is not intended to be used by a customer or purchaser but rather

by a sales representative (see Brief page 11). The examiner respectfully disagrees with

both arguments.

Initially the examiner would like to point out that an Appellant cannot show

nonobviousness by attacking references individually. *In response to applicant's*

arguments against the references individually, one cannot show nonobviousness by

attacking references individually where the rejections are based on combinations of

references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck &

Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, it is well within the

level of one of ordinary skill in the art to port a DOS based application to any other

platform such as Windows or the Internet. Thus, the particular operating system and

hardware used by IBM is irrelevant to the combination of Henson and IBM because the

examiner is not arguing for incorporating the operating system and underlying hardware

of IBM with Henson. Instead, the examiner is arguing that adding images to a text-

based configuration system is a well-known enhancement in the art. To further support

the point that the operating system and hardware used by IBM is irrelevant to the issue

at hand, the examiner cites the following references:

- "PenRight unleashes Windows tool" by Diana Hwang ("Hwang");

- "Sequent exec leaves to 'take a shot at Internet gold rush'" by Anita Marks
  ("Marks")

These references do not constitute a new grounds of rejection. They serve only to

establish the state of the industry at a particular point in time prior to the Appellant's

invention. These references were presented to the Appellant in the "Arguments" section

of the Final Office action and have been presented here for the Board's benefit. Hwang

discloses that it is well known in the art to port a DOS-based application to a windows

environment in order to take advantage of more powerful equipment. Marks, on the

other hand, discloses that it is well known in the art to port a Windows application to the

World Wide Web in order to take advantage of the Internet. Thus, the Examiner

strongly disagrees with the Appellant's argument that the Visual Configurator of IBM

teaches away from the feature of claim 1. Hwang and Marks show that porting an

application from one environment to another environment is an obvious modification

that is well within the level of one of ordinary skill in the art. Moreover these references

also show that one of ordinary skill in the art would recognize that the teachings of IBM

are not limited to any particular operating system or hardware but rather that they can

be implemented across multiple platforms. The Appellant has not provided any

evidence to counter these points.

Regarding the Appellant's second argument that the VC taught by IBM is not

intended to be used by a customer or purchaser but rather by a sales representative,

the examiner notes that claim 1 recites the limitation "user". A "user" can be a sales

representative or a customer. Because the claim language does not make a distinction

between a customer and a sales representative, it is unclear to the examiner why this

distinction should be an issue in the prior art. Indeed the term "user" is broad enough to

encompass both a sales representative and a customer. For at least these reasons, the

examiner maintains that the combination of Henson and IBM is proper.

The Appellant has also argued that combining Motomiya with the teachings of

Henson and IBM in the rejection of claim 1 is improper because Motomiya is directed to

designing jewelry and therefore non-analogous art (see Brief pages 12 and 13). In

addition, the Appellant alleges there is no motivation for the combination (see Brief

pages 14 and 15). The examiner respectfully disagrees with these arguments. In the

Final Office Action, the examiner stated that the combination of Henson and IBM does

not teach providing an image to the client system over a network or allowing a user to

select an image over a network. The examiner then cited the Motomiya reference for

these limitations.

Motomiya teaches an Internet-based, e-commerce system and method for

configuring an accessory such as a necklace, pendent, ring, earring, or bracelet

(Abstract; col. 2, line 63 – col. 3, line 10). Motomiya discloses that during the design

process, the user is provided with an image of the accessory (Figure 5A, "54"; Figure

5B, "57"; Figure 6A, "63") and images of accessory components (Figure 5A, "52" and

"53"; Figure 5B, "56"; Figure 6A, "62") that are selected by the user in designing the

accessory via a network connection (col. 3, line 50 – col. 4, line 10; col. 5, lines 6-50).

The examiner argued that Motomiya is reasonably pertinent to the field of online product

configuration. Henson's invention is directed to an online, e-commerce, text-based

configuration system and method. IBM's invention is directed an image-based

configuration system and method which, as noted in the reference, is an improvement

over an existing text-based configuration system. Motomiya's invention is directed an

Internet-based, e-commerce, image-based configuration system and method that

transmits images to the client via network. Thus, since the prior art references are from

the same field of endeavor, the examiner maintains the position that Henson, IBM, and

Motomiya are analogous art. Moreover the Supreme Court noted in *KSR International*

v. Teleflex Inc. the following:

> "*Throughout this Court's engagement with the question of*
> *obviousness, our cases have set forth an expansive and flexible*
> *approach inconsistent with the way the Court of Appeals applied its*
> *TSM test...Neither the enactment of §103 nor the analysis in*
> *Graham disturbed this Court's earlier instructions concerning the*
> *need for caution in granting a patent based on the combination of*
> *elements found in the prior art...The combination of familiar*

elements according to known methods is likely to be obvious when

it does no more than yield predictable results."

In the present case, the Appellant has done nothing more than combine familiar

elements from the prior art according to known methods to achieve a predictable result.

For these reasons, the examiner respectfully requests the Board to affirm the

examiner's rejection of claims 1, 9-11, 13, 16, 49, 52, 53, 57, and 58 under 35 U.S.C.

103(a).

Referring to the rejection of claims 2-4, 6-8, 56, 66, and 73, the Appellant has

argued that Motomiya does not teach the feature of claim 2 because it is not in the

same field as Henson and IBM (see Brief pages 16 and 17). The examiner respectfully

disagrees. As noted above, Motomiya is in the same field of endeavor as Henson and

IBM. Moreover, Motomiya in fact teaches the feature of claim 2. Claim 2 states nothing

more than displaying to the user the final configured product having the user-selected

components. Motomiya explicitly teaches displaying to the user a final configured

product having all the user-selected components (Figure 6B). For this reason, the

examiner respectfully requests the Board to affirm the examiner's rejection of claims 2-

4, 6-8, 56, 66, and 73 under 35 U.S.C. 103(a).

Referring to the rejection of claim 5, the Appellant has argued that the cited prior

art fails to teach this feature (see Brief page 17). The examiner respectfully disagrees.

Motomiya in fact teaches the limitations of this claim as noted in the Final Office Action.

For this reason, the examiner respectfully requests the Board to affirm the examiner's

rejection of claim 5 under 35 U.S.C. 103(a).

Referring to the rejection of claims 12 and 14, the Appellant has argued that the

cited prior art fails to teach this feature (see Brief page 18). The examiner respectfully

disagrees as noted in the Final Office Action. For this reason, the examiner respectfully

requests the Board to affirm the examiner's rejection of claims 12 and 14 under 35

U.S.C. 103(a).

Referring to the rejection of claims 17, 25-27, 29, 32, 51, 62, 67, and 68, the

Appellant has argued that the examiner has mischaracterized the claims and has

improperly applied the principle of non-functional descriptive matter to the claimed

invention (see Brief Pages 19-22). The examiner respectfully disagrees.

Initially the examiner would like to point out that the only distinction between

claim 1 and claim 17 is that the word "system" in claim 1 has been replaced by the word

"measurement system" in claim 17. The rest of the claim language between the two

claims is identical. Moreover, both claims 1 and 17 are directed to configuring a system

(i.e. a product) by allowing a user to manipulate the *image* of the product displayed on a

screen. Thus the only distinction between claims 1 and 17 is the *image* displayed to the

user. In addition, the examiner notes that the method steps of claim 17 are

implemented in an "e-commerce system" and that the images are passed over a

network. Therefore it is inherent that the steps of claim 17 are implemented by some

sort of computer program. In rejecting claim 17, the examiner noted that the prior art

teaches or suggests all the limitations of the claim 17 with the exception of the particular

image recited in the claim language. The examiner considered the claim language as a

whole and concluded that this *image* is non-functional because it is not functionally

related to the substrate. MPEP 2106(IV)(B)(1)(b) clearly sets forth the guidelines for

determining whether or not nonfunctional descriptive material is present in claim

language by stating the following:

> "Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer."

Thus the analysis requires the examiner to determine whether or not the particular

image displayed creates any functional interrelationship, either as part of the stored

data or as part of the computing processes performed by the computer. In the present

case, the examiner cannot find any such functional interrelationship. In arguing against

the examiner's rejection, the Appellant appears to be arguing that the term

"measurement" is the patentably distinct feature over the prior art. The examiner

disagrees because neither the image displayed nor the program of the e-commerce

system performs any sort of measurement functions. If the Appellant's arguments are

correct then simply replacing the word "measurement" in claim 17 with the word

"television" or the word "radio" would lead to two distinct patents. Clearly, one of

ordinary skill in the art (i.e. a computer science graduate) would recognize that this

cannot be the case particularly when the functions of a television or radio are not recited

anywhere in the claim language. For this reason, the examiner respectfully requests

the Board to affirm the examiner's rejection of claims 17, 25-27, 29, 32, 51, 62, 67, and 68 under 35 U.S.C. 103(a).

Referring to the rejection of claim 33, the Appellant has argued that the cited prior art fails to teach the features of this claim (see Brief page 23). The examiner respectfully disagrees and notes that Henson and IBM teach configuring a computer system wherein the customizable components are electronic devices (e.g. see Henson Figures 2, 3A, and 4; Figure 3A, "77", "75"; Figure 5, "92"). For this reason, the examiner respectfully requests the Board to affirm the examiner's rejection of claim 33 under 35 U.S.C. 103(a).

Referring to the rejection of claim 76, the Appellant has argued that the cited prior art fails to teach the features of this claim (see Brief page 24). The examiner respectfully disagrees and notes that Henson and IBM teach configuring a computer system (e.g. see Henson Figures 2, 3A, and 4; Figure 3A, "77", "75"; Figure 5, "92"). A computer system is inherently an electronic system. For this reason, the examiner respectfully requests the Board to affirm the examiner's rejection of claim 76 under 35 U.S.C. 103(a).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

NAEEM HAQ
PRIMARY EXAMINER

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